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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,468	12/04/2001	Paul Chen	2908.P8	2293

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

ARAQUE JR, GERARDO

ART UNIT	PAPER NUMBER
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3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/000,468	CHEN ET AL.	
	Examiner	Art Unit	
	Gerardo Araque Jr.	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26, 29, 30 and 33-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26, 29-30, 33-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1 – 3, 5, 9, 12 – 15, 18, 23 – 25 and 27 – 35** are rejected under 35

U.S.C. 102(e) as being anticipated by **Chan et al.** (US Patent 6,378,070 B1).

3. In regard to **claims 1, 9, 14, 18, 24, 27, 29, 31, 33, and 35**, Chan discloses a method and network system using secure printing where the user uploads a selected document, identifying the intended recipient for the document, and, inherently, location information (Column 2 Lines 15 – 19). The location information is inherently uploaded with the print data information so that the system knows where the print data information is being uploaded from. This is mostly seen in offices and college campuses where multiple users from multiple computers are using the same printers. The printer must receive the location information in order to determine the proper identification information of the logged-in user requesting the print job. Once the proper identification information has been identified the printer would then print a cover page containing the identification information with the correlated print data information.

Chan also discloses that a smart card is used within the system as an option to retrieve the encrypted information (Column 5 Lines 6 – 9). As a result, it must be inherent that when an individual uploads the identification information of the intended recipient the system would, consequently, correlate the identification information with the key information (smart card). Furthermore, a document store is connected to the network, which receives and stores encrypted document files and associated user identities. “The document store 130 also receives requests to forward to specified locations encrypted document files having a specified identity (Column 3 Lines 54 – 61).” Chan also discloses the recipient providing the printing apparatus with a second identifier (identification information) to receive documents from the print server (Column 2 Lines 22 – 26). Once the second identifier is confirmed, which was inputted at the printing apparatus, the print data information is forwarded to the printing apparatus to have it printed (Column 2 Lines 27 – 34).

4. In regards to **claim 2**, it is inherently included that if multiple computers are connected to the same network some type of identifier must be assigned to the computer, such as the IP Address or Network Address.

5. In regards to **claim 3**, it is inherently included that when connecting a computer to an existing network the server must assign it an identifier, such as an IP Address or Network Address.

6. In regard to **claims 5, 12, 23, 25, 28, 30, 32, and 34**, Chan discloses a directory server, which has access to a database of user-specific information, known as user-profiles (Column 3 Lines 35 – 37). “The directory server **120** is arranged to receive from

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requesting processes requests for specific information for particular users, and returns the specific information to the requesting process, whenever possible (Column 3 Lines 37 – 41).” Moreover, Chan discloses that it is, “...necessary for a printer to identify itself in enough detail that the billing system **150** could allocate billed funds to the printer’s owner (Column 5 Lines 55 – 57).”

7. In regards to **claim 13**, Chan discloses, “...the document store **130** can be a modified print spooler or print server process which has access to a large amount of data storage...(Column 3 Lines 62 – 64).”

8. In regards to **claim 15**, Chan discloses a method and network system using secure printing where the user uploads a selected document, identifying the intended recipient for the document, and, inherently, location information (Column 2 Lines 15 – 19). It is inherently included that when connecting a computer to an existing network the server must assign it an identifier, such as an IP Address or Network Address.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 4 and 36** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chan et al.** (US Patent 6,378,070 B1) in view of **Newton** (Newton’s Telecom Dictionary 17th Edition).

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11. In regard to **claims 4 and 36**, it would have been obvious to one of ordinary skill at the time of the invention that if the printing network as disclosed by Chan were to be used in a hotel, a hotel server would be used. The function that is being carried out would be the same regardless of where the server is as is stated by Newton (Newton Page 614 - 615 Server).

12. **Claims 6 – 8, 10 – 11, 16 – 17, 19, 20, 21 – 22, 26, and 37 – 38** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chan et al.** (US Patent 6,378,070 B1).

13. In regard to **claims 6 – 8, 10 – 11, 16 – 17, 19, 21 – 22, 26, and 37 – 38**, it would have been obvious to one of ordinary skill at the time of the invention that if the printing network as disclosed by Chan were to be used in a hotel, the location information must comprise hotel information and the server to be used must be a hotel server. The function that is being carried out would be the same regardless of where the printing network, as disclosed by Chan, was located. Regarding the identification information, it is old and well known that various forms of identification can be used depending on the situation. If the case of a hotel it would have been obvious that the identification information would be the room key information. It is old and well known that when staying at a hotel, or the like, information is kept under the room that you stayed at, the credit card used to pay for the stay, and/or the last name and first name of the individual staying and/or paying for the hotel room.

14. In regards to **claim 20**, it would have been obvious that if an individual was staying at a hotel and using the hotel's network services user identification must be given to the individual by the hotel in order to use the hotel's network services.

15. **Claims 39 – 40** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chan et al.** (US Patent 6,378,070 B1) in view of **Tognazzini** (US Patent 6,195,420 B1).

16. In regards to **claim 39**, Chan is disclosed above but fails to teach printing billing information.

Tognazzini, however, does teach a system where a hotel guest receives a printed copy of the bill. As a result, the Tognazzini discloses that the invention allows a hotel guest increased flexibility in determining when the bill is prepared and how disputes over errors or omissions are resolve (Column 1 Lines 61 – 64).

Therefore, it would have been obvious to one of ordinary skill at the time of the invention in view of the teachings of Tognazzini to modify Chan to have an option of printing billing information in order to allow a hotel guest increased flexibility in determining when the bill is prepared and how disputes over errors or omissions are resolve.

17. In regards to **claim 40**, Tognazzi discloses that in-room checkout systems are offered by many hotels in order to permit a guest to view the bill and authorize payment (Column 1 Lines 11 – 12).

Response to Arguments

18. Applicant's arguments filed 2/1/07 have been fully considered but they are not persuasive.

Arguments towards Claims 1 and 29 (including amendments made)

19. Applicants argue that Chan fails to teach uploading location information corresponding to a location where the uploading is performed with the print data, and then determining user identification information based on the uploaded location information, and correlating the determined user identification information with the print data. However, Chan discloses uploading identifier information with the print data to a print server, inputting second identifier information at the printing apparatus and transmitting it to the print server, the print server comparing the second identifier with the stored first identifier and, for matching identifiers (Column 2 Lines 15 – 34). As already previously discussed Chan discloses that the process is done on a TCP/IP network and that it is inherent that an IP address must be provided. Once an IP address has been provided for the user it is also inherent that the IP address must be attached to the document in order to avoid any confusion with various other users who are uploading the information as well. Chan discloses that various identifiers are used in order to provide a secure printing network. One skilled in the art would know that the IP address must correspond to some user profile, which is also disclosed by Chan (Column 3 Lines 35 – 37), in order for the proper document to be printed. Further still, the using identifiers, such as the location from which the uploading was performed, user identifications, and etc., to keep track of printing jobs are used in various organizations and institutions, such as universities and offices running various computers at one time. Moreover, Chan also discloses that the system can be used worldwide, which would

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further require uploading location information that would correspond to a user in order provide a secure and effective printing service (Column 7 Lines 55 – Column 8).

The examiner also notes that Newton and Tognazzini references were not used as part of the rejections made toward claims 1 and 29.

Arguments towards claims 9 and 14 (including amendments made)

20. Applicants argue that Chan fails to anticipate the claimed invention for the same reasons as mentioned above. However, those reasons have already been discussed above. Claims 9 and 14 are both apparatuses used to carry out the method. As a result, Chan already discloses a server that is capable of carrying out the method of the claimed invention, as discussed in the above Office Action.

Arguments toward claim 18 (including amendments made)

21. Applicants argue the for the same reasons as mentioned above, as well as Chan not teaching that uploaded location information is used to determine key information. However, Chan discloses that the print server compares the second identifier with the stored fired identifier and, for matching identifiers. As result, Chan discloses that various identifiers can be used in order to correlate all of the necessary information to provide a secure printing network. Depending on where the system is to be used would depend on what information is to be used for the correlation. As far as the examiner is concerned, the key information is still a form of identification information, which the examiner has discussed in detail above as well as in the previous Office Action.

Arguments toward claim 35 (including amendments made)

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22. Applicants argue that Chan fails to disclose that the intended recipient's information is hotel guest information. However, it has already been discussed that Chan uses a database which stores various user profiles. As a result, the hotel guest information is only information regarding to a user, which Chan clearly discloses. Moreover, applicants also argue that it has not been known for hotels to issue their guests smart-cards to their guests. However, the examiner has found various references prior to applicants filing date, which disclose that it was known for hotels to issue their guests with smart cards. Some of which are the following: 5,204,633; 5,525,417; and 5,530,232.

Arguments toward claims 24 and 33 (including amendments made)

23. Applicants argue that Chan fails to disclose whether a user is registered/authorized to use the printing apparatus and denying access if the user is not registered/authorized. However, Chan discloses a method and system of secure printing. Moreover, Chan discloses the importance of security and implements an authentication functionality (Column 4 Lines 13 – 17), which would determine whether or not the user is authorized to use the printing apparatus. Applicants also claim that Chan merely utilizes user identification information input at a printer via a smart-card to determine if a print job is pending, and if so, prints out the print job. Examiner finds no reference of Chan disclosing this.

Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

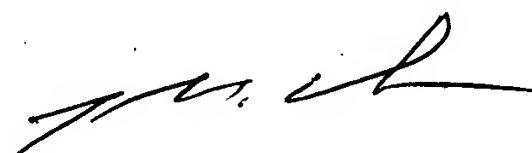
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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